

## **REMARKS**

**[0002]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 2, 4-22, and 24-28 are presently pending. Claims amended herein are: 1, 12, 20-22, 24-26, and 28. Claims withdrawn or cancelled herein are: 3 and 23. No new claims are added herein.

### **Statement of Substance of Interview**

**[0003]** The Examiners graciously talked with me—the undersigned representative for the Applicant—on Apr. 9, 2008. Applicant greatly appreciates the Examiners' willingness to talk. Such willingness is invaluable to each of us in our common goal of an expedited prosecution of this patent application.

**[0004]** During the interview, I discussed how the claims differed from the cited references. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0005]** The Examiners were receptive to the proposals, and we discussed additional clarifications. I understood the Examiners to tentatively concur with the discussed clarifying amendments to claim 20. For example, the Examiners were receptive to a discussed amendment that clarifies distinguishing a subscriber ID and a client device ID. However, the Examiner indicated that he would need to review the cited references and complete an updated search upon receiving a formal response.

**[0006]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

### **Formal Request for an Interview**

**[0007]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0008]** Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

### **Claim Amendments**

**[0009]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 12, 20-22, 24-26, and 28 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

## **Substantive Matters**

### **Claim Rejections under § 102 and §103**

**[0010]** Claims 1-28 are rejected under 35 U.S.C. § 102 and § 103. The Examiner rejects claims 1-2 and 4-28 under § 102. In addition, the Examiner rejects claim 3 under § 103.

**[0011]** In light of the amendments presented herein and the discussion during the above-discussed Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

**[0012]** The Examiner's rejections are based upon the following references alone and in combination:

- **Eldering:** *Eldering, et al.*, US Patent Application Publication No. 2004/0148625; and
- **Eldering 129:** *Eldering*, US Patent No. 6,216,129.

### **Overview of the Application**

**[0013]** The Application describes a technology for targeting advertisements based on consumer purchasing data. Profiles are generated for broadcast television system subscribers based on consumer purchasing data maintained, for example, by retail and service providers. A particular advertisement is targeted by associating the advertisement with one or more characteristics from a consumer profile which also identifies client devices associated with consumers. A client device is configured to receive a message indicating an upcoming targeted advertisement, compare locally stored subscriber profile data with the profile characteristics associated with the targeted advertisement, and

determine whether to tune to the targeted advertisement or to allow the default advertisement to be rendered.

### Cited References

**[0014]** The Examiner cites Eldering as the primary reference in the anticipation- and obviousness-based rejections. The Examiner cites Eldering 129 as the secondary reference in the obviousness-based rejection.

### Eldering

**[0015]** Eldering describes an ad management system (AMS) for managing sales and insertion of targeted advertisements into advertising opportunities.

### Eldering 129

**[0016]** Eldering 129 describes an advertisement selection system of vectors describing an actual or hypothetical market for a product or desired viewing audience.

## **Rejections**

**[0017]** Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

### **Lack of Prima Facie Case of Obviousness (MPEP § 2142)**

**[0018]** Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

**[0019]** The Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Eldering in view of Eldering 129. Applicant respectfully traverses the rejection of this claim. Claim 1 as amended incorporates the subject matter of former claim 3.

### **Based upon Eldering**

**[0020]** The Examiner rejects claims 1-2 and 4-28 under 35 U.S.C. § 102(e) as being anticipated by Eldering. Applicant respectfully traverses the rejection of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

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<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent Claim 1

**[0021]** Applicant submits that Eldering does not anticipate this claim because it does not disclose the following elements as recited in this claim (as amended, with emphasis added):

- processing consumer data that represents an individual's consumer purchases, wherein the **consumer data comprises data collected by a retail store in association with a membership card that is assigned to the individual and comprises a unique consumer ID**; and
- **targeting** a television advertisement to the individual based on the consumer data by **associating the unique consumer ID and a unique client device ID, such that based on the client device ID, a client device associated with the individual:**
  - determines when the client device ID is associated with the client device; and
  - acquires the targeted advertisement.

**[0022]** In rejecting claim 1, the Examiner cites Eldering, paragraphs [0030], [0031], [0037]; and Fig. 1 – specifically items 102, 108, and 110. (Office Action, page 2.)

**[0023]** Eldering, paragraph [0030] states:

Generally, an advertisement management system (AMS) in accordance with the principles of the present invention consists of one or more subsystems which allow for the characterization of the advertisement, determination of advertising opportunities (avails), characterization of the subscriber,

correlation of the advertisement with a subscriber or group of subscribers, and sale of the advertisement, either through a traditional placement (sale), an Internet based sale, or an Internet based auction.

**[0024]** Eldering, paragraph [0031] states:

As illustrated in **FIG. 12**, an **AMS 100** comprises an ad characterization module **102**, an avail opportunities module **104**, a subscriber characterization module **108**, a correlation module **100**, and an avail sales/auctioning module **112**. The **AMS 100** is also configured to communicate to an ad insertion module **114**. The ad insertion module **114** may be located within the **AMS 100** or may be located externally.

**[0025]** Eldering, paragraph [0037] states:

Private data can also be amassed and can include specific viewing habits or purchase records of the subscriber. Alternatively, the subscriber may complete questionnaires and forms that indicate lifestyle, product preference and previous purchases. All the available private and public information is used by the subscriber characterization module **108** for characterizing one or more subscribers. The subscriber characteristics may be based upon some known features. For example, it is known that the Nielsen data tracks the number of households watching particular TV programming. In accordance with the principles of the present invention, such information may be used to characterize one or more characteristics of the subscribers.

**[0026]** Claim 1 as amended incorporates the subject matter of former claim 3. In rejecting claim 3, the Examiner cites Eldering 129, columns 6 and 8 – lines 33-51 and 13-17, respectively. (Office Action, page 12.)

**[0027]** Eldering 129, (c 6, ll. 33-51) states:

Data to perform the consumer profiling is received from a point of purchase **110**. Point of purchase **110** can be a grocery store, department store, other retail outlet, or can be a web site or other location where a purchase request is received and processed. In a preferred embodiment, data from the point of purchase is transferred over a public or private network **120**, such as a local area network within a store or a wide area network which connects a number of department or grocery stores. In an alternate embodiment the data from point of purchase **110** is transmitted over the Internet **150** to profiler **140**.

Profiler **140** may be a retailer who collects data from its stores, but can also be a third party who contracts with consumer **100** and the retailer to receive point of purchase data and to profile the consumer **100**. Consumer **100** may agree to such an arrangement based on the increased convenience offered by targeted ads, or through a compensation arrangement in which they are paid on a periodic basis for revealing their specific purchase records.

**[0028]** Eldering 129, (c 8, ll. 13-17) states:

The consumer ID **512** can be any identification value uniquely associated with consumer **100**. In a preferred embodiment consumer ID **512** is a telephone number, while in an alternate embodiment consumer ID **512** is a credit card number. Other unique identifiers include consumer name with middle initial or a unique alphanumeric sequence, the consumer address, social security number.

**[0029]** However, both Eldering & Eldering 129 fail to teach each of the features of claim 1 as amended at least because neither reference nor the combination suggests use of



a unique client device ID in association with a unique consumer ID for targeting advertising to a particular device.

**[0030]** Consequently, because Eldering and Eldering 129 do not teach all of the elements and features of this claim, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claim 20

**[0031]** Claim 20 includes at least one feature similar to the claimed features discussed above with respect to claim 1 and is allowable for at least similar reasons as claim 1 is allowable. In addition, the system of claim 20 differs from the AMS described in Eldering at least because the claimed system operates at the client device controlling content rendering between the operator (such as a cable operator) and the client device whereas the Eldering AMS manages the process between the operator and advertisers to sell and insert content in a program stream before transmission to subscribers.

**[0032]** Eldering does not disclose at least the following elements of claim 20 (as amended, with emphasis added):

A client device having a unique client device ID, the client device comprising:

\* \* \*

a subscriber profile data repository configured to maintain consumer profile data comprising a unique subscriber ID and the unique client device ID;

a profile filter configured to direct the first tuner to tune to an alternate network channel over which a targeted advertisement may be

**is received when a consumer profile characteristic associated with the targeted advertisement matches the television subscriber profile data**

**[0033]** Instead, the disclosure of Eldering teaches “*Once the ad has been inserted in a program stream by the ad insertion module 114, the ad is transmitted to the subscriber along with the actual program stream for viewing.*” [0087]

**[0034]** Additionally the Office indicates (Office Action, page 12 regarding previous claim 23) “it is inherent if there is a determination to transmit a targeted advertisement to a subscriber based on their profile that the profile *must* be associated with a specific destination device in order to transmit the advertisement to the intended target.” (emphasis added).

**[0035]** Applicant notes that it is not necessary that a profile be associated with a specific device in Eldering and that the stated inherency is not taught by the cited reference. Indeed, the cited reference teaches *maintaining subscriber data on a “Secured Correlation Server (SCS)”* [0013], a “*subscriber characterization module 108*” [0032], and “All available private and public information is used by the subscriber characterization module 108 for characterizing one or more subscribers,” [0037]. The reference teaches the AMS utilizing cable television nodes, zip codes, tax records, and a variety of other criteria to match available advertising slots with provided ad characteristics to target advertising to consumers.

*Independent Claims 12, 24, and 26*

**[0036]** Similarly, independent claims 12, 24, and 26 each include at least one feature similar to the claimed features discussed above with respect to claims 1 and 20. Thus, independent claims 12, 24, and 26 are allowable over the cited references for at

least similar reasons as claims 1 and 20. Accordingly, Applicant asks the Examiner to withdraw the rejections of these claims.

Dependent Claims 2, 4-11, 13-19, 21, 22, 25, 27, and 28

**[0037]** These claims ultimately depend upon one of independent claims 1, 12, 20, 24, and 26. As discussed above, claims 1, 12, 20, 24, and 26 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**Dependent Claims**


**[0038]** In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

## Conclusion

**[0039]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC  
Representatives for Applicant

  
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